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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,964

12/14/2004

Christoph Luthy

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3774

26748

7590

06/26/2008

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PATENT AND TRADEMARK DEPARTMENT
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,964

Applicant(s)

LUTHY ET AL.

Examiner

Sabiha Qazi

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Non-Final Office Action

Claims 1-5 are pending. No claim is allowed at this time. Amendments are entered.

Summary of this Office Action dated Saturday, June 21, 2008

1. Election/Restriction
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 103(a) Rejections
6. Communication

DETAILED ACTION

Election/Restrictions

1. Claims 1-5 are pending.
2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: The compounds of formula (I) contain W which represents a 4- to 7-membered, saturated, partially saturated or unsaturated ring system (U), which contains a ring element U₁, and may contain from one to four further ring nitrogen atoms, and/or two further ring oxygen atoms, and/or two further ring sulfur atoms and/or one or two further ring elements U₂, and the ring system U may be mono- or poly-substituted at a saturated or unsaturated ring carbon atom and/or at a ring nitrogen atom by a group R₈, and two substituents R₈ together are a further fused-on or spirocyclic 3- to 7-membered-ring system which may be unsaturated, partially saturated or fully saturated and may in turn be substituted by one or more groups R_{8a} and/or interrupted once or twice by a ring element -O-, -S-, -N(R_{8b})- and/or -C(=O)-; and U₁ and U₂ are each independently of the other(s) -C(=O)-, -C(=S)-, -C(=NR₆)-, -(N=O)-, -S(=O)- or -SO₂-;

L is either a direct bond, an -O-, -S-, -S(O)-, -SO₂-, -N(R_{5a})-, -SO₂N(R_{5b})-, -N(R_{5b})SO₂-, -C(O)N(R_c)- or -N(R_{5c})C(O)- bridge, or a C-C₄alkylene, C₂-C₂-alkenylene or C₂-C₂-alkynylene chain which may be mono- or poly-substituted by R₅ and/or interrupted once or twice by an -O-, -S-, -S(O)-, -SO₂-, -N(R_{5d})-, -SO₂N(R_{5e})-, -N(R_{5e})SO₂-, -C(O)N(R_{5f})- and/or -N(R_{5f})C(O)-

bridge, and when two such bridges are present those bridges are separated at least by one carbon atom, and W is bonded to L by way of a carbon atom or a -N(R5e)SO₂- or -N(R5f)C(O)- bridge when the bridge L is bonded to the nitrogen atom of W.

The heterocyclic groups as defined in the definition of W, have different, divergent chemical structures and possess different properties, therefore claims lack unity of invention. Therefore, invention as claims lacks unity of invention.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The claims are deemed to correspond to the species listed above in the following manner:
4. Claims as presented are drawn to Markush group. Thousands of compounds encompass the generic formula as in claim 1. The invention is further divided by Applicants in separated formula one of them is formula 1Aa1) on page 49, the elected species of compound A1.001 has

been elected from this generic formula. All the invention is drawn to various types of compounds which are structurally and chemical different. Each is drawn to a separate invention. The following claim(s) are generic: Claims 1 and 2.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the reasons cited above.

6. During a telephone conversation with Mr. Thomas Hamilton on 6/18/08 on provisional election was made with traverse to prosecute the invention of elected species of compound A1.001 on page 49 of the specification, reads on claims 1 and 3-5. Affirmation of this election must be made by applicant in replying to this Office action. Claim 2 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

The references disclosed in search report are not provided, therefore not initialed by the Examiner.

Examiner notes that cited reference in search report EP 0270260 A1 is not related to present invention. It is drawn to surgical device.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Copending Applications

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

Applicants must disclose all the pending applications and related Patents.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

35 U.S.C. 103(a)—Rejection

Claim 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over RUEGG, WILLY (WO 01/54501). The reference generically teaches compounds and a herbicidal composition that, in addition to comprising customary inert formulation adjuvants, comprises: a) a compound of formula (I); and b) a synergistically effective amount of one or more compounds of formulae (2.1 to 2.51). The compositions according to the invention may also comprise a safener. Compounds of the prior art are structurally similar to the presently claimed compounds and are generically taught. See the entire document especially abstract, compounds of formula (1a) on page 28; compounds of formula (1d, Table 3) on page 51; formula (II) on page 31; formula 1 on page 1 and 2 and Q3 on page 5.

Instant claims differ from the reference in that they are of different generic scope. It had been held by Courts that the indiscriminate selection of “some” from among “many” is considered prima facie obvious. In re Lemin, 141 USPQ 814 (1964); National Distillers and Chem. Corp. V. Brenner, 156 USPQ 163.

The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the genus of the above cited references with the expectation of obtaining additional beneficial compounds. The instant claimed compounds would have been suggested to one skilled in the art.

One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within the genus. In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in Merck & Co. V. Biocraft Laboratories, 874 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Elected species of compound A1.001 in table A1 (page 49) is not disclosed by the prior art specifically.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/

Primary Examiner, Art Unit 1612

